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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/694,065	10/19/2000	John F. Acres	4164-158	8782

7590

03/17/2004

Alan T. McCollom
MARGER JOHNSON & McCOLLOM, P.C
1030 S.W. Morrison Street
Portland, OR 97205

EXAMINER

COBURN, CORBETT B

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 03/17/2004

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Notice of Abandonment

Application No.

09/694,065

Examiner

Corbett B. Coburn

Applicant(s)

ACRES, JOHN F.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☐ Applicant's failure to timely file a proper reply to the Office letter mailed on _____.
 - (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) ☐ A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - (d) ☐ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) ☐ The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.
The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.
 - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☒ The reason(s) below:

See Attached

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

Communication Re: Appeal

Application No.

~~00/000,000~~ 09694 065

Applicant(s)

SMITH

Examiner

S. Thomas Hughes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

1. ☐ The Notice of Appeal filed on _____ is not acceptable because:

- (a) ☐ it was not timely filed.
- (b) ☐ the statutory fee for filing the appeal was not submitted. See 37 CFR 1.17(b).
- (c) ☐ the appeal fee received on _____ was not timely filed.
- (d) ☐ the submitted fee of \$_____ is insufficient. The appeal fee required by 37 CFR 1.17(b) is \$_____.
- (e) ☐ the appeal is not in compliance with 37 CFR 1.191 in that there is no record of a second or a final rejection in this application.
- (f) ☐ a Notice of Allowability, PTO-37, was mailed by the Office on _____.

2. ☐ The appeal brief filed on _____ is NOT acceptable for the reason(s) indicated below:

- (a) ☐ the brief and/or brief fee is untimely. See 37 CFR 1.192.
- (b) ☐ the statutory fee for filing the brief has not been submitted. See 37 CFR 1.17(c).
- (c) ☐ the submitted brief fee of \$_____ is insufficient. The brief fee required by 37 CFR 1.17(c) is \$_____.

The appeal in this application will be dismissed unless corrective action is taken to timely submit the brief and requisite fee. Extensions of time may be obtained under 37 CFR 1.136(a).

3. ☒ The appeal in this application is DISMISSED because:

- (a) ☐ the statutory fee for filing the brief as required under 37 CFR 1.17(c) was not timely submitted and the period for obtaining an extension of time to file the brief under 37 CFR 1.136 has expired.
- (b) ☐ the brief was not timely filed and the period for obtaining an extension of time to file the brief under 37 CFR 1.136 has expired.
- (c) ☐ Request for Continued Examination (RCE) under 37 CFR 1.114 was filed on _____.
- (d) ☒ other: See attached

4. ☒ Because of the dismissal of the appeal, this application:

- (a) ☒ is abandoned because there are no allowed claims.
- (b) ☐ is before the examiner for final disposition because it contains allowed claims. Prosecution on the merits remains CLOSED.
- (c) ☐ is before the examiner for consideration of the submission and prosecution has been reopened pursuant to 37 CFR 1.114.

S. Thomas Hughes
SPE
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DETAILED ACTION

On 3 February 2003, Applicant submitted an Appeal Brief. This Appeal Brief was defective because of improper grouping of the claims. Applicant was notified of these defects on 19 May 2003. Applicant filed another Appeal Brief on 19 June 2003. Examiner reopened prosecution to correct a typographical error in the Final Rejection (one of the claims had not been listed as rejected) and informed the Applicant that the grouping of the claims was still improper. Examiner warned the Applicant that should Applicant submit another Appeal Brief with improper grouping of the claims, 37 CFR 1.192(d) requires that the appeal will stand abandoned. Applicant was told that this was automatic and that Examiner did not have discretion in the matter.

On 3 December 2003, Applicant submitted another Appeal Brief. Once again, the grouping of the claims is defective.

37 CFR §1.192(c)(7) states:

Grouping of claims. For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

The MPEP further states:

Where, however, the appellant (A) omits the statement required by 37 CFR 1.192(c)(7) yet presents arguments in the argument section of the brief, or (B) includes the statement required by 37 CFR 1.192(c)(7) to the effect that one or more claims do not stand or fall together (i.e., that they are separately patentable) yet does not offer argument in support thereof in the "Argument" section of the brief, the appellant should be notified of the noncompliance as per 37 CFR

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1.192(d). Ex parte Schier, 21 USPQ2d 1016 (Bd. Pat. App. & Int. 1991); Ex parte Ohsumi, 21 USPQ2d 1020 (Bd. Pat. App. & Int. 1991).

There are several defects in the grouping of claims. The following is not an exhaustive list:

1. In at least three cases, for a single ground of rejection (Claims 33, 40 & 43-49 as being anticipated by LeStrange; Claims 1-10 & 12 as obvious over Jorasch in view of Kishishita; and claims 17-30, 32 and 55-61 as obvious over Jorasch in view of LeStrange), Applicant has failed to state that the claims are separately patentable and do not stand or fall together. Yet Applicant argues some claims as standing and falling together and some as separately patentable.

Applicant seems to have attempted to get around the requirement of the rules by dividing the claims into two groups. This does not comply with the rule.

2. In many of the groups, Applicant states that the claims are separately patentable. Yet in almost every case, Applicant fails to explain why the claims are believed to be separately patentable. Instead, Applicant points out differences in what the claims cover (i.e., additional limitations contained in the claims). As 37 CFR §1.192(c)(7) clearly states, "Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable." The rule requires Applicant to explain why the additional limitation makes the claim separately patentable. Applicant has consistently failed to make any such explanation.

3. In Group VIII, 55 & 56 and 57 & 58. Applicant does not even point out differences between the claims.

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4. In Group IX, Applicant states that claims 38, 39, 41, and 42 are separately patentable, but fails to argue the separate patentability of claims 38 and 39 and 41 and 42. Applicant argues 38 & 39 as one subgroup and 41 & 42 as another subgroup.

5. In Group XIV, Applicant states that claims 52-54 are separately patentable, but fails to argue the separate patentability of claims 53 and 54. Applicant does not even point out differences between the claims.

As noted above, this is not an exhaustive list. Applicant has been repeatedly warned that all problems with the grouping of the claims had to be corrected or the case would be abandoned by operation of law. On at least two occasions, Examiner has referred Applicant to 37 CFR §1.192(d), which states:

If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and provided with a period of one month within which to file an amended brief. If appellant does not file an amended brief during the one-month period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

Applicant has repeatedly filed an amended brief which does not overcome all the reasons for non-compliance stated in the notification. Thus the appeal stands dismissed. Furthermore, since there are no allowable claims, the Application is abandoned.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (703) 305-3319. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

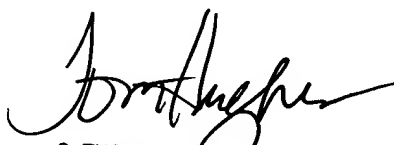
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



cbc



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